



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,815	07/12/2000	HELMUT LOTH	H3146	3579

423 7590 07/02/2002

HENKEL CORPORATION  
2500 RENAISSANCE BLVD  
STE 200  
GULPH MILLS, PA 19406

EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

8

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s) <i>OT 8</i>
	09/530,815 Examiner Judy M. Reddick	LOTH ET AL. Art Unit 1713
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
<p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>12 July 2000</u>.</p> <p>2a)<input type="checkbox"/> This action is FINAL.      2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>		
<b>Disposition of Claims</b>		
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>6-26</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>6-26</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b>		
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11)<input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner.</p> <p style="margin-left: 20px;">If approved, corrected drawings are required in reply to this Office action.</p> <p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
<p>13)<input checked="" type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input checked="" type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p>1.)<input checked="" type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2.)<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3.)<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>* See the attached detailed Office action for a list of the certified copies not received.</p> <p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).</p> <p>a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
<b>Attachment(s)</b>		
<p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u>.</p> <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p>		

**DETAILED ACTION**

**Priority**

1. **Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.**

**Information Disclosure Statement**

2. **The information disclosure statement filed 12/04/00 has been considered and placed in the application file.**

**Claim Rejections - 35 USC § 112**

3. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

***The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.***

4. **Claims 12 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no express support can be found for the limitation "a copolymer of 85 to 98% by weight acrylate and 2 to 10% by weight acrylonitrile" per the claims supra, and, as such, this engenders a New Matter situation.**

**Claim Rejections - 35 USC § 112**

5. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

6. *Claims 6-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

- A) *The recited "copolymers of at least one acrylate and acrylonitrile" per claim 6 constitutes indefinite subject matter as per it not being known by any rules of Chemistry that would allow for a copolymer to comprise "monomer(s)" VS "units of monomer(s)". See, also claims 12, 16, 19, 20 and 23 relative to the above matter.*
- B) *The recited "fatty compounds" per claims 6 and 15 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.*
- C) *The recited contents per claims 7-11 and 19 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact entity that such is being based on, i.e., total jointing compound or other.*
- D) *The recited "additionally comprising one or more additional components" per claim 10 engenders redundant subject matter.*
- E) *The recited "fatty alcohols and derivatives thereof and having a molecular weight between 300 and 1,500" per claim 17 constitutes indefinite subject matter as per: a) the metes and bounds of "derivatives thereof" engender and indeterminacy in scope; b) it is not readily ascertainable if "number average" or "weight average" is the qualifying entity for the recited "molecular weight", the two being substantially different. See also claim 19 (b) relative to "derivatives thereof".*
- F) *The recited "comprising a copolymer" per claim 20 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited component (a). Is it the same as or in addition to the already cited copolymer?*

G) The recited "comprising one or more fatty acid esters" prior claim 21 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited component (b).

H) Claim 25, in its entirety, engenders awkwardly and ambiguously expressed claim language as well as incomplete process steps.

#### **Allowable Subject Matter**

7. Claims 6-26 are deemed allowable. The claims would be allowed if amended, rewritten and/or satisfactorily rebutted so as to overcome the 112 issues raised supra. The instantly claimed invention is deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the precisely defined polyacrylate jointing compound, as claimed. One having ordinary skill in the art would not have been endowed with any motivation to extrapolate the precisely defined polyacrylate jointing compound, as claimed, from any of the prior art of record with any reasonable expectation of success.

#### **Conclusion**

8. The prior art made of record and not relied upon is considered illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Application/Control Number: 09/530,815  
Art Unit: 1713

Page 5

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

*J. M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *Jmr*  
June 29, 2002

# REFERENCE COPYING SPECIAL INSTRUCTIONS

DATE 6/29/02

APPLICATION SERIAL NUMBER 09/530,815

NUMBER OF COPIES: Standard copy production for regular applications is 2 copies; for PCT applications it is 4 copies. If additional copies are required, please note below.

ADDITIONAL COPIES REQUIRED \_\_\_\_\_

RETURN ORIGINAL(S) WITH CASE \_\_\_\_\_

COPY PTO-1449 ✓

OTHER: \_\_\_\_\_